

REMARKS

In response to the Office Action mailed on March 31, 2003 and received in Application No. 09/498,805, please consider the amendments above and the following remarks. Following these amendments, Claims 1-5, 9-15, 19-28, 32-38, 44, 45, 47, 49-54, 57-60, 62, 64, 66-73, 78-83, 89, 90, 92, 94-100, 103-105, 107, 109, 111-121, 163, 164, 168-173 and 175 remain in the application. In the Office Action, several formal matters were asserted prior to the substantive rejections. The formal matters are dealt with first hereinbelow, followed by the substantive rejections.

Formal Objections

An information disclosure statement filed June 19, 2000 was not considered due to an alleged failure to comply with 37 CFR 1.98(a)(2) requiring legible copies of each U.S. and foreign patent. Applicant has record of mailing of an information disclosure statement on June 15, 2000 and subsequent receipt by the USPTO of the information disclosure statement on June 19, 2000. The Examiner returned the first page of the information disclosure statement mailed on June 15, 2000 with markings indicating that the first page had been considered. However, the second page has not been returned which the Applicant interprets as indicating that the rejection applies to the second sheet of the information disclosure statement mailed on June 15, 2000. Applicant is resubmitting copies of the references in said second sheet in a new supplemental Information Disclosure Statement and respectfully requests consideration of the currently submitted references. Applicant also asks that the Examiner notify the undersigned if any other reference copies are missing from the file.

It was also requested in the Office Action that the specification be checked for possible minor errors. Applicant has done so and the minor spelling and grammatical corrections have been entered as shown above.

Claims 1-5, 9-10, 21-28, 32-38, 44-45, 47, 49-54, 57-60, 62 and 64 were objected to because of an improper use of antecedent basis. In particular, the dispatch system is referred to as "a dispatch system" twice in independent Claims 1 and 21. As shown above, the clause reciting "a dispatch system" has been moved and the second instance has been amended to

recite “the dispatch system” and the objection has therefore been overcome with respect to Claims 1 and 21. Claims 2-5, 9-10, 22-28, 32-38, 44-45, 47, 49-54, 57-60, 62 and 64 were objected to for being dependent upon one of the objected-to Claims 1 or 21 which have been amended as described above. The objection with respect to Claims 2-5, 9-10, 22-28, 32-38, 44-45, 47, 49-54, 57-60, 62 and 64 has therefore also been overcome.

35 U.S.C. §112

Claims 32, 44-45, 47, 57, 89-90, 92, 96 and 109 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In particular, Claims 32, 47 and 57 were rejected for depending from cancelled claims. Each of Claims 32, 47 and 57 have been amended to depend from a currently pending claim. Claims 44, 45, 89 and 90 were rejected for use of the term “can” which is allegedly indefinite for being optional. The term “can” has been replaced with “is capable of,” or similar language that is not optional.

Claims 96 and 109 were rejected under 35 U.S.C. §112, second paragraph, because it was allegedly not clear from which claims they were meant to depend, and whether they should be method or apparatus claims. Claim 96 is a method claim that has been amended to depend from method Claim 66. Originally, Claim 96 incorrectly recited a dependency from Claim 21. Similarly, Claim 109 is a method claim and incorrectly recited a dependency from Claim 21, but has been amended to depend from method Claim 66. As a result, the rejection of Claims 32, 44-45, 47, 57, 89-90, 92, 96 and 109 under 35 U.S.C. §112, second paragraph has been overcome.

35 U.S.C. §§102(b) and 103(a)

Claims 1-5, 9-15, 19-23, 28, 33-36, 38, 51-53, 58-64, 66-68, 73, 78-81, 83, 97-98 and 103-107 were rejected under 35 U.S.C. §102(b) as being anticipated by PCT Publication WO 96/13015 to Kadaba et al. (“Kadaba”). Claims 111-112, 120-121, 163-164 and 168-169 were rejected under 35 USC §102(b) as being anticipated by PCT Publication WO 98/24036 to Wilz et al. (“Wilz”). The remaining claims were rejected under 35 U.S.C. §103(a) over various combinations of Kadaba, Wilz and/or U.S. Patent No. 5,910,896 to Hahn-Carlson (“Hahn”).

Kadaba

Applicant notes that Kadaba has issued as U.S. Patent No. 6,285,916 on September 4, 2001 and has the same assignee as the present application.

Kadaba discloses a multiple-stage parcel delivery receiving system. As shown in Figure 1, the receiving system 10 includes a hand-held data processing device 12, such as a personal digital assistant (PDA), which has an input-output (I/O) circuit 20. The I/O circuit controls communications with outside devices through a modem 22, an infrared port 23 and a wand scanner 25. In addition, the receiving system also includes a personal computer (PC) 40 capable of communicating with the PDA via the infrared port. The PC is also connected to a central tracking computer 45 and a printer 48. The PDA is also capable of communicating with a portable data acquisition device (DIAD) 35 used in conventional package delivery to transmit tracking information via the I/O circuit.

During operation of the receiving system of Kadaba, a parcel delivery service employee 300 drops off one or more parcels or packages at a mail room of a company, as shown in Figure 3. A person at the mailroom checks in the delivery by scanning the information into the PDA from a label on the package using the wand, or downloads the tracking information from the DIAD via the I/O circuit, as described at page 11, lines 15-34. The downloaded information includes, among other things, a tracking number and the identity of the intended recipient.

During distribution from the mailroom, checkout occurs by an internal delivery person physically delivering the parcels to a recipient's location, or by the recipient coming to the mail room to acquire the parcels, as described at page 13, lines 5-8. At the recipient's location (or at the mail room in the case of the recipient coming to the mail room), the internal delivery person scans a bar code on the parcels using the wand, thereby uploading the tracking number to the PDA. When all of the packages have been scanned, the internal delivery person enters the first and last names of the recipient, as described at page 13, lines 8-19 of Kadaba. The internal delivery person then hands the PDA to the recipient who signs for the parcels in a window and taps a confirmation button, as described at page 13, lines 32-35.

Wilz

Wilz has an international publication date of June 4, 1998, which is less than one year prior to the February 7, 1999, priority date of the present application (as indicated by the separate Amendment to Claim Priority to Provisional Application filed concurrently herewith) and is therefore potentially not prior art with respect to the present application. Although the Applicant differentiates the disclosure and teachings of Wilz from the present invention in the remarks below, such arguments should not be considered an admission that Wilz is applicable prior art. Therefore, the Applicant expressly reserves the right to swear behind Wilz, or otherwise remove or refute Wilz's status as prior art with respect to the present application. In addition, Applicant notes that U.S. Patent No. 6,464,139 appears to correspond to Wilz and a copy of the patent has been submitted in a supplemental Information Disclosure Statement.

Wilz describes a bar-code driven system for accessing information resources on the Internet. As shown in Figure 1 of Wilz, the system includes a bar-code symbol reader **7a** for reading bar code symbols encoded with information representative of Internet addresses. Connected to the bar-code reader is a computer **6** with an Internet browser configured to open a web page in response to the address scanned by the reader. The computer includes a printer **35**.

In one aspect, the system is capable of being used as a web-based package routing, tracking and delivery (RTD) system, as shown in Figure 9. The RTD aspect includes a log-in procedure for each package wherein i) an RTD internet server **51** is accessed by reading a bar code symbol specifying the address of the RTD server on the Internet (Figure 11), ii) package-related information is entered into the RTD server via the Internet, iii) a label is created containing a bar-code symbol and a delivery address and iv) the label is applied to the package prior to "shipping for carrying out routing, tracking and delivery functions," as described at page 55, lines 31-32 and page 56, lines 1-9 of Wilz.

The bar-code symbol printed on the label describes an Internet address assigned to the package and the zip code of the package's delivery destination. During delivery, the location of the package can be registered with the RTD system by scanning the bar-code symbol.

Scanning the bar code symbol also reveals the destination zip code for routing of the package. Final delivery within the zip code is facilitated by the delivery address on the label.

Hahn

Hahn discloses a shipment transaction system that includes a bill-of-lading (BOL) rating engine **30** connected to a shipper processor **24** which, in turn, is connected to a shipper access terminal **32** having a data processing device **34**, as shown in Figure 1. The shipper access terminal is connected in communication with a central processor **40**. In addition, the central processor is connected to a carrier processing device **46**.

During operation, the shipper processor acts in conjunction with the BOL engine to generate a rated BOL, as described at column 4, lines 5-18 of Hahn. The shipper processor sends the BOL through the access terminal which generates transaction information and then forwards the transaction information to the central processor. The carrier processor receives proof of delivery information and sends it to the central processor. The central processor processes and stores the shipment information and allows access to the information by the shipper, carrier and other authorized users.

In one aspect, the data processing device of the shipper access terminal validates the rated BOL to ensure that the rated BOL contains data which is complete, error-free and properly formatted before converting it to transaction information, as described at column 5, lines 41-46. Table 1 of Hahn shows that the transaction information includes a zip code at column 6, line 18. Hahn also mentions that the data processing device may be implemented using a conventional personal computer.

Independent Claims 1, 11, 21 and 66

Each of independent Claims 1, 11, 21 and 66 was rejected under 35 USC §102(b) as being anticipated by Kadaba. Each of these claims recites a system or step for receiving a pickup and shipping order entered by a customer over an Internet-accessible computer system and generating a dispatch order for pickup of the package in response to receipt of the customer-entered pickup and shipping order. Notably, the dispatch order requests pickup of the package at one of a plurality of locations.

Kadaba does not teach or disclose receiving an order entered by one of its customers via the Internet to pick up a package from one of several locations and deliver the package to an intended recipient. Kadaba is directed to transfer of a package to a second delivery stage and the quick communication of delivery information from a DIAD of a carrier to a mailroom computer and a PDA. In this manner, the mailroom has a record of receipt of the package and can complete delivery of the package within the company, with confirmation of final delivery via signature of the recipient on the PDA.

Kadaba does disclose uploading of delivery information, including information on the packages, from the DIAD of the carrier to a mailroom computer system to facilitate internal distribution of the packages by an internal delivery person. Kadaba also discloses pickup of packages by the recipient at the mailroom, or delivery by the internal delivery person from the mailroom to the recipient's location, subsequent to upload of the delivery information.

However, entry of recipient information and subsequent delivery from, or distribution at, a mailroom is not the same as the pickup and shipping order submitted by the customer, as recited in Claims 1, 11, 21 and 66. The pickup and shipping order of Claims 1, 11, 21 and 66 requests pickup from one of a plurality of locations, and not just a single location, such as the mailroom disclosed by Kadaba. The ability of the present invention, as described in Claims 1, 11, 21 and 66, to dispatch to different locations for pickup allows for, among other things, shipping by customers who do not have regular pickups by a carrier, and only ship packages on an occasional basis. Kadaba distributes the packages to different locations with confirmation via recipient signatures, but does not pickup the packages from separate locations. Thus, although known pickup systems exist, such as systems wherein requests for pickup of packages are made telephonically as described in previously disclosed reference number 6 "Customers Spend Less Phone Time with New Voice Recognition System," Kadaba does not anticipate the present system.

Wilz discloses entry of delivery information into an RTD system over the Internet. However, Wilz does not discuss dispatch of a service person for pickup of the package at one of a plurality of locations. Hahn discloses a system wherein bills-of-lading are generated and

submitted to a carrier via a network, but no mention is made of dispatch of a service person for pickup of a package.

Claims 1, 11, 21 and 66 have been amended to clarify that the customer-entered order is a pickup and shipping order requesting pickup at one of a plurality of locations. As a result, Kadaba, Wilz, Hahn and the remaining cited references, alone and in combination, fail to teach or suggest independent Claims 1, 11, 21 and 66. Therefore, the rejection of Claims 1, 11, 21 and 66 under 35 USC §102(b) over Kadaba has been overcome and Claims 1, 11, 21 and 66 are allowable.

Independent Claims 111 and 163

Each of the remaining independent Claims 111 and 163 was rejected under 35 USC §102(b) as being anticipated by Wilz. Each of the Claims 111 and 163 recites a method including the steps of receiving shipping information as part of a customer-entered order, validating the shipping information associated with the order and then generating a shipping label in response to validation of the shipping information.

Wilz describes accessing of the RTD system over the Internet, entry of package-related information and creation of a shipping label bearing a delivery address and a bar code. Wilz, however, does not discuss validation of the shipping information before it can be used to generate a shipping label. Hahn discloses validation of bill-of-lading information, including delivery address information, before its conversion to transaction information. However, this validation occurs after the BOL is generated and is not a precondition for printing of the BOL. Kadaba discloses upload of delivery information to a mailroom computer, and subsequent release or distribution of the mail to the recipient. Correct delivery is ensured by entry of the recipient's name and signature in the PDA. However, neither of these confirmation steps is a precondition to printing of a label.

As a result, Wilz, Hahn, Kadaba and the remaining cited references alone, and in combination, fail to teach or suggest independent Claims 111 and 163. Therefore, the rejection of Claims 111 and 163 under 35 USC §102(b) over Wilz has been overcome and Claims 111 and 163 are allowable.

Dependent Claims

Each of the remaining dependent Claims 2-5, 9-10, 12-15, 19-20, 22-28, 32-38, 44, 45, 47, 49-54, 57-60, 62, 64, 67-73, 78-83, 89, 90, 92, 94-100, 103-105, 107, 109, 112-121, 164, 168-173 and 175 depends from, and further patentably distinguishes, a respective one of independent Claims 1, 11, 21, 66, 111 and 163. As a result, the rejection of dependent Claims 2-5, 9-10, 12-15, 19-20, 22-28, 32-38, 44, 45, 47, 49-54, 57-60, 62, 64, 67-73, 78-83, 89, 90, 92, 94-100, 103-105, 107, 109, 112-121, 164, 168-173 and 175 under 35 U.S.C. §§102(b) and 103(a) over Kadaba, Wilz and Hahn alone, or in combination, has also been overcome. Claims 2-5, 9-10, 12-15, 19-20, 22-28, 32-38, 44, 45, 47, 49-54, 57-60, 62, 64, 67-73, 78-83, 89, 90, 92, 94-100, 103-105, 107, 109, 112-121, 164, 168-173 and 175 are therefore also allowable.

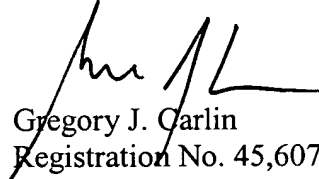
In view of the remarks and amendments presented above, it is respectfully submitted that claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. The Examiner is requested to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

Applicant directs the Examiner's attention to the currently filed supplemental Information Disclosure Statement that discloses, among other references, U.S. Patent No. 6,464,139 which appears to correspond to Wilz. Examiner is also directed to earlier-filed supplemental Information Disclosure Statements mailed on July 8, 2003; June 10, 2003; and May 14, 2003 which appear to have been received after mailing of the present Office Action.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

In re: Hillbush et al.
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Filed: 02/07/2000
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Respectfully submitted,

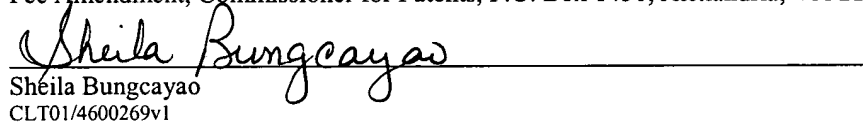


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